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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/980,651	01/24/2002	Tetsuya Tsunekawa	1319-01	7108

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EXAMINER

SIMONE, CATHERINE A

ART UNIT PAPER NUMBER

1772

DATE MAILED: 12/01/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

CLO 10

Office Action Summary	Application No. 09/980,651	Applicant(s) TSUNEKAWA ET AL.	
	Examiner Catherine Simone	Art Unit 1772	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Withdrawn Rejections

1. The 35 U.S.C. 102 rejection of claims 1, 4, 7 and 9 as anticipated by Greener et al. of record in Paper #8, Page 2, Paragraph #2 has been withdrawn due to the Applicant's arguments in Paper #9.
2. The 35 U.S.C. 103 rejection of claims 3 and 10 over Greener et al. in view of White et al. of record in Paper #8, Page 3, Paragraph #4 has been withdrawn due to the Applicant's argument in Paper #9.
3. The 35 U.S.C. 103 rejection of claims 2, 5, 6 and 8 over Greener et al. of record in Paper #8, Page 4, Paragraph #5 has been withdrawn due to the Applicant's argument in Paper #9.

Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1 and 3-10 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-18 of U.S. Patent No. 6,420,011. Although

the conflicting claims are not identical, they are not patentably distinct from each other because the claims and the specification of U.S. Patent 6,420,011 are broad enough to encompass or include that which is recited in the present patent application.

Tsunekawa et al. teaches a biaxially oriented polyester film for use in a capacitor having high heat resistance, comprising a polyester (A) as a main component and a polyimide (B) (see col. 3, lines 25-28), and having a glass transition temperature in the range of 105°C to 145°C (see col. 5, lines 22-29), a surface roughness (Ra) in the range of 10 nm to 140 nm (see col. 15, line 42). However, Tsunekawa et al. fails to disclose the elongation at break in a machine direction of 70% to 150%. Although, Tsunekawa et al. does teach the film being stretched in the machine direction at a ratio of 3.0 to 10 times and does teach a breaking frequency of the film (see Table 1 and Table 2). Therefore, one of ordinary skill in the art would have readily determined the elongation at break in a machine direction depending on the desired end results. Thus, it would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have provided the polyester film in Tsunekawa et al. with an elongation at break in a machine direction of 70% to 150%, since one of ordinary skill in the art would have readily determined the desired elongation at break in the machine direction depending on the desired end results as shown by Tsunekawa et al.

Regarding claims 5 and 6, Tsunekawa et al. fails to teach an onset temperature of dielectric loss in the range of 85°C to 120°C and an insulation volume resistance (IR) in the range of $1.0 \times 10^{14} \Omega \cdot \text{cm}$ to $5.0 \times 10^{16} \Omega \cdot \text{cm}$ at 125°C. However, Tsunekawa et al. does teach an insulation resistance and a dielectric breakdown voltage (see col. 17, lines 39-67 and col. 18, lines 1-19). Therefore, one of ordinary skill in the art would have readily determined an onset

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temperature of dielectric loss and an insulation volume resistance depending on the desired end results. Thus, it would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have provided the polyester film in Tsunekawa et al. with an onset temperature of dielectric loss in the range of 85°C to 120°C and an insulation volume resistance (IR) in the range of $1.0 \times 10^{14} \Omega \cdot \text{cm}$ to $5.0 \times 10^{16} \Omega \cdot \text{cm}$ at 125°C., since one of ordinary skill in the art would have readily determined the desired onset temperature of dielectric loss and an insulation volume resistance depending on the desired end results as shown by Tsunekawa et al.

Regarding **claims 3 and 4**, note the polyester is composed mainly of ethylene terephthalate and the polyimide is composed of polyether imide (see col. 3, lines 25-29). Regarding **claim 7**, note the polyimide (B) in a content in the range of 5 to 30% by weight based on the total weight of the film (see Table 1, examples 1-4). Regarding **claim 9**, note a metallized layer disposed on at least one surface of the film (see col. 16, lines 49-50). Regarding **claim 10**, note the metallized film for use in a capacitor (see col. 17, lines 37-42).

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

7. **Claims 1 and 3-10** are rejected under 35 U.S.C. 102(e) as being anticipated by Tsunekawa et al. (6,420,011).

Tsunekawa et al. teaches a biaxially oriented polyester film for use in a capacitor having high heat resistance, comprising a polyester (A) as a main component and a polyimide (B) (see col. 3, lines 25-28), and having a glass transition temperature in the range of 105°C to 145°C (see col. 5, lines 22-29), a surface roughness (Ra) in the range of 10 nm to 140 nm (see col.15, line 42) and inherently an elongation at break in the machine direction of 70% to 150%, since Tsunekawa et al. does disclose a biaxially oriented polyester film containing the same materials as that which is being disclosed in the present application and the film is being stretched in the machine direction at a total ratio of 3 to 10 times (see col. 11, lines 5-10). Regarding **claims 3 and 4**, note the polyester is composed mainly of ethylene terephthalate and the polyimide is composed of polyether imide (see col. 3, lines 25-29). Regarding **claims 5 and 6**, the polyester film inherently has an onset temperature of dielectric loss in the range of 85°C to 120°C and inherently an insulation volume resistance (IR) in the range of 1.0×10^{14} , since Tsunekawa et al. does disclose a biaxially oriented polyester film containing the same materials and the same biaxial orientation and the same use as that which is being disclosed in the present application.

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Regarding **claim 7**, note the polyimide (B) in a content in the range of 5 to 30% by weight based on the total weight of the film (see Table 1, examples 1-4). Regarding **claim 9**, note a metallized layer disposed on at least one surface of the film (see col. 16, lines 49-50). Regarding **claim 10**, note the metallized film for use in a capacitor (see col. 17, lines 37-42).

Response to Arguments

8. Applicant's arguments with respect to claims 1 and 3-10 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

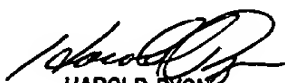
9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Catherine Simone whose telephone number is (703)605-4297. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on (703) 308-4251. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9311.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



Catherine Simone
Examiner
Art Unit 1772
November 19, 2003



HAROLD PYON
SUPERVISORY PATENT EXAMINER
1772

11/25/03